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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,419	04/23/2001	Werner Blumenstock	Q63542	3448

7590 07/28/2005

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EXAMINER	
NGUYEN, DUC M	
ART UNIT	**PAPER NUMBER**
2685	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,419	BLUMENSTOCK ET AL.	
	Examiner	Art Unit	
	Duc M. Nguyen	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *16 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/16/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's response filed on 5/16/05. Claims 1-22 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1, 9, 13 and 16, the claims recites "an automated **manufacturing** system". However, it is noted that the specification **never** use the term "manufacturing" nor describe in any paragraph that would reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of this narrowly claimed limitation from a broad sense of the term "automation system" (see also "Merrian Webster's Collegiate Dictionary", Tenth edition, regarding the definition of the term "automation"). Therefore, the "automated **manufacturing** system" is a new subject matter.

Claim Rejections - 35 USC ∋ 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Stripf** et al (US **6,263,487**) in view of **Hong** et al (US 5,710,883).

Regarding claim **1, Stripf** discloses a method for remote diagnosis of an automated manufacturing system, wherein a Java program is used to generate software function blocks (or instruction) for executing control programs which controlled by a monitoring device that can be connected to the Internet and operated over the Internet (see Fig. 1 and cols 2-5), this would comprise all the claimed limitations except for email messages carrying these control programs. However, **Hong** discloses a method wherein email messages are used to carry software or hypertext file over the Internet that allows updates to pass through security firewalls without compromising server security while minimizing network traffic and resources (see **col. 5, line 66 – col. 6, line 15**). Here, since the system in **Stripf** must transport software function blocks over the Internet and security firewalls, it would have been obvious to one skilled in the art at the time the invention was made to further incorporating the above teachings of **Hong** to **Stripf** for utilizing advantages of email messages as mentioned above by transporting

software function blocks or control programs for diagnosis in an automated manufacturing system using email message as claimed, for allowing diagnostic programs pass through security firewalls without compromising server security while minimizing network traffic and resources.

Regarding claim **2,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Stripf** as modified would disclose the instruction comprises at least one function as claimed, for diagnosis purpose.

Regarding claim **3,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Stripf** as modified would discloses the application comprises a component (hardware) as claimed, in order to run an application.

Regarding claim **4,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Stripf** as modified would disclose the first and second E-mail messages as claimed, in order to send the instruction and receive diagnosis results for diagnosis purpose.

Regarding claim **5,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Stripf** as modified would disclose the configuration as claimed, for diagnosis purpose.

Regarding claim **6,** the claim is rejected for the same reason as set forth in claim 5 above. In addition, it would have been obvious to one skill in the art to modify the above teachings of **Stripf** and **Hong** for encrypting/decrypting e-mails as claimed, for security purpose.

Regarding claim **7,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Stripf** as modified would disclose the identification field and text field for email messages as claimed, in order to route an email message to the intended controller.

Regarding claim **8,** the claim is rejected for the same reason as set forth in claim 7 above. In addition, it is clear that **Stripf** as modified would disclose the address, sender, date and time, and text fields for email messages as claimed, for administration purpose.

Regarding claims **9-22,** the claims are interpreted and rejected for the same reason as set forth in claims 1-8 above, wherein **Stripf** as modified would disclose the instruction is at least one of to control, operate and monitoring the application of the system (see **Stripf, col. 1, lines 40-51**);

5. Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Wookey** (US Pat. Number **6,085,244**) in view of **Naugle** (US **5,715,393**) and **Crater** et al (US **5,805,442**).

Regarding claims **1-6, 9-16, 18-22, Woodkey** discloses a method for remote diagnosis of an automation system, which would comprise all the claimed limitations (see entire document), wherein **Woodkey** discloses

- a firewall system (see **col. 5, lines 16-25**);

- monitoring software and new test instructions (see **col. 6, lines 32-52**);

- automatic executing the test and automatic return the test result (see **col. 3, lines 1-6, col. 8, lines 42-52, and col. 9, lines 7-10**);

- data encryption and decryption for communication (see **col. 10, lines 34 – 65**);

- the instruction is at least one of to control, operate and monitoring the application of the system (see **col. 11, lines 29-67**);

Here, although the general description of the remotely monitoring system as described by **Woodkey** appears more dedicate to a dial-up modem link, it is noted that **Woodkey** does mention the use of an e-mail message as a communication link (see **col. 4, lines 13-16**). Since using an email message for diagnosis is known in the art as disclosed by **Naugle** (see **Abstract, Fig. 2 and col. 4, line 1 – col. 5, line 60**), and since **Woodkey** does mention the use of an e-mail message, it would have been obvious to one skilled in the art to combine the above teachings of **Naugle** and **Wookey** for providing a diagnosis system utilizing an email message for diagnosis as claimed, for being able to monitor the correct operation of a remote computer system without requiring a log on to that system (see **Naugle, col. 5, lines 54-60**).

Regarding the added limitation of an automated manufacturing system, although **Naugle** and **Wookey** fails to disclosed an automated manufacturing system, it is noted that the remote diagnosis of a computer network would applicable and would work equal well in an automated manufacturing system as mentioned by **Crater** (see **col. 1, lines 12-16** and **col. 1, lines 53-57** and **col. 2, lines 10-17**). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to further incorporating the above teachings of **Naugle** and **Wookey** to an automated

manufacturing system as mentioned by **Crater** as well, for utilizing email messages for diagnosis in an automated manufacturing system as claimed, for being able to monitor the correct operation of a remote computer system without requiring a log on to the automated manufacturing system (see **Naugle, col. 5, lines 54-60**).

Regarding claims **7-8, 17,** the claims are rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Woodey** and **Naugle** as modified would disclose address filed, sender field, date and time field, and subject filed as claimed (see Naugle, col. 4, lines 15-67).

6. Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kuwabara** (US Pat. Number **6,065,136**) in view of **Wookey** (US Pat. Number **6,085,244**) and **Crater** et al (US **5,805,442**).

Regarding claim **1, Kuwabara** discloses a system for remote diagnosis of device troubles, wherein electronic mail (e-mail) messages for sending the instruction and receiving diagnosis results are utilized (see **Fig. 1** and **col. 5, line 63 - col. 6, line 35**), which would include all the claimed limitations except for a firewall and automatic monitoring feature. However, it is clear that the system as described by **Kuwabara** would work equally well in an automatic monitoring system comprising a firewall as disclosed by **Wookey** (see **Fig. 3**, **col. 2, line 54 – col. 3, line 17** and **col. 5, lines 16-37**), wherein the diagnosis results are also reported via the internet utilizing e-mail messages (see **col. 4, lines 13-17** and **col. 22, lines 16-20**). Therefore, it would have been obvious to one skill in the art to combine the above teachings of **Wookey** and

Kuwabara for providing a secured (firewall) system with automatic monitoring features as claimed, for reducing or eliminating required intervention by the customer and the service center both to collect the system diagnostic information, and to process it (see Wookey, col. 3, lines 7-17). Here, when incorporating the diagnosis of device in Kuwahara to Wookey's system, it is clear that the instruction program should be modified to execute the instruction automatically as teach by Wookey since the required intervention by the customer has been eliminated.

Regarding the added limitation of an automated manufacturing system, although **Kuwabara** and **Wookey** fails to disclosed an automated manufacturing system, it is noted that the remote diagnosis of a computer network would applicable and would work equal well in an automated manufacturing system as mentioned by **Crater** (see **col. 1, lines 12-16** and **col. 1, lines 53-57** and **col. 2, lines 10-17**). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to further incorporating the above teachings of **Kuwabara** and **Wookey** to an automated manufacturing system as mentioned by **Crater** as well, for utilizing email messages for diagnosis in an automated manufacturing system as claimed, for being able to monitor the correct operation of a remote computer system without requiring a log on to the automated manufacturing system (see **Naugle, col. 5, lines 54-60**).

Regarding claim **2,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the instruction comprises at least one function as claimed, for diagnosis purpose.

Regarding claim **3,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would discloses the application comprises a component (hardware) as claimed, in order to run an application.

Regarding claim **4,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the first and second E-mail messages as claimed, in order to send the instruction and receive diagnosis results for diagnosis purpose.

Regarding claim **5,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the configuration as claimed, for diagnosis purpose.

Regarding claim **6,** the claim is rejected for the same reason as set forth in claim 5 above. In addition, it would have been obvious to one skill in the art to modify the above teachings of **Wookey** and **Kuwabara** for encrypting/decrypting e-mails as claimed, for security purpose as disclosed by **Wookey** (see col. 10, lines 34-43, 55-65).

Regarding claim **7,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the identification field and text field as claimed (see **Kuwabara**, Figs 3-4).

Regarding claim **8,** the claim is rejected for the same reason as set forth in claim 7 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the address, sender, date and time, and text fields as claimed (see Figs 3-4), for administration purpose.

Regarding claims **9-22,** the claims are interpreted and rejected for the same reason as set forth in claims 1-8 above, wherein **Kuwabara** and **Wookey** would disclose the instruction is at least one of to control, operate and monitoring the application of the system (see **Wookey, col. 11, lines 29-67**);

Response to Arguments

7. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sepe, Jr. US (6,792,321), Remote Web-based control.

10. **Any response to this final action should be mailed to:**

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry)

(571)-273-7893 (for informal or draft communications).

Hand-delivered responses should be brought to Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893, Monday-Thursday (9:00 AM - 5:00 PM).

Or to Edward Urban (Supervisor) whose telephone number is (571) 272-7899.

Duc M. Nguyen

July 23, 2005